

**REMARKS**

The Office Action dated March 16, 2005, has been received and reviewed.

Claims 1-47 are currently pending and under consideration in the above-referenced application, each standing rejected. Claims 21 and 32 have been canceled without prejudice or disclaimer. New claims 48-51 have been added.

Reconsideration of the above-referenced application is respectfully requested.

**Preliminary Amendment**

Please note that a Preliminary Amendment was filed in the above-referenced application on July 16, 2004, but that the undersigned attorney has not yet received any indication that the Preliminary Amendment has been entered into the Office file for the above-referenced application. If, for some reason, the Preliminary Amendment has not yet been entered into the Office file, the undersigned attorney would be happy to provide the Office with a true copy thereof.

**Rejections Under 35 U.S.C. § 102**

Claims 1-5, 9, 10, 15-21, and 24-29 stand rejected under 35 U.S.C. § 102(b) for reciting subject matter which is purportedly anticipated by that described in U.S. Patent 758,491 to Woodman (hereinafter "Woodman").

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Woodman describes an embossing punch that includes male and female dies 18 and 19. The male and female dies 18 and 19 are connected to one another and biased apart from each other by a spring 20. As illustrated in Figs. 2-4, the female die 19 includes an upper surface with two rivets 24 protruding therefrom. Recesses 25 formed in a surface of an upper jaw 12 of the punch 10 are configured to receive the rivets 24 as the female die 19 is positioned adjacent to the

upper jaw 12 and the male die 18 is positioned adjacent to the lower jaw 11 of the punch 10. The rivets 24, their corresponding recesses 25, and the spring 20 work in conjunction with one another to retain the dies 18 and 19 in position relative to the jaws 11 and 12. *See* Lines 58-75.

The system of amended independent claim 1 also includes a press with a die retaining element. The die retaining element of amended independent claim 1 differs from that disclosed in Woodman, however, in it is associated with a substantially planar, uninterrupted die receiving surface, rather than the die receiving surface of the jaw 12 of Woodman's punch 10, which is interrupted by recesses 25.

As Woodman does not anticipate each and every element of amended independent claim 1, under 35 U.S.C. § 102(b), the subject matter recited in amended independent claim 1 is allowable over the subject matter disclosed in Woodman.

Claims 2-5, 9, and 10 are each allowable, among other reasons, for depending directly or indirectly from claim 1, which is allowable.

Independent claim 15, as amended and presented herein, is drawn to a method for forming a pattern from a sheet of material. The method of amended independent claim 15 includes, among other things, securing a planar back side of a substantially planar die to a substantially planar, uninterrupted die securing surface.

Woodman includes no express or inherent description of securing a planar back side of a substantially planar die to a substantially planar, uninterrupted die securing surface. Instead of being secured to a surface of the lower jaw 11 of Woodman's punch 10, the male die 18 merely rests upon that surface. The female die 19, which may be secured in place relative to a corresponding surface of the upper jaw 12, does not include a planar back side; nor is the corresponding surface uninterrupted. Rather, the female die 19 includes protruding rivets 24 that are configured to be received by recesses 25 that interrupt the surface of the upper jaw 12.

As Woodman does not anticipate each and every element of amended independent claim 15, under 35 U.S.C. § 102(b), the subject matter recited in amended independent claim 15 is allowable over the subject matter described in Woodman.

Each of claims 16-20 is allowable, among other reasons, for depending directly or indirectly from claim 15, which is allowable.

Claim 21 has been canceled without prejudice or disclaimer, rendering the rejection thereof moot.

Independent claim 24 is directed to a hand-held system for forming patterns from a sheet of material. The system of independent claim 24, as amended and presented herein, includes a hand-held press and at least one die with a substantially planar back side that is securable to a substantially planar, substantially uninterrupted die receiving surface of a first member of the hand-held press.

As the punch 10 described in Woodman includes only one die (*i.e.*, female die 19) that is securable to a surface of a jaw 12 thereof, and since that surface is not substantially uninterrupted (it is interrupted by recesses 25) and the back side of the female die 19 is not planar (it has rivets 24 protruding therefrom), Woodman does not expressly or inherently describe, or anticipate, each and every element of amended independent claim 25. Therefore, the 35 U.S.C. § 102(b) rejection of independent claim 25 cannot be maintained.

Claims 25 and 26 are both allowable, among other reasons, for depending directly from claim 24, which is allowable.

The method of amended independent claim 27 includes securing a planar back side of an embossing die to a substantially planar, substantially uninterrupted die receiving surface. Again, Woodman does not expressly or inherently describes securing a planar back side of a die to a substantially planar, uninterrupted die receiving surface.

Claims 28 and 29 are both allowable, among other reasons, for depending directly from claim 27, which is allowable.

For these reasons, withdrawal of the 35 U.S.C. § 102(b) rejections of claims 1-5, 9, 10, 15-21, and 24-29 is respectfully solicited.

**Rejections Under 35 U.S.C. § 103(a)**

Claims 6-8, 11-14, 22, 23, and 30-47 stand rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Woodman in View of Benson

Claims 6-8 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over that taught in Woodman, in view of teachings from U.S. Patent 5,660,105 to Benson et al. (hereinafter "Benson").

Claims 6-8 are each allowable, among other reasons, for depending directly or indirectly from claim 1, which is allowable.

Woodman in View of Jaffin

Claim 11 is rejected under 35 U.S.C. § 103(a) for being directed to subject matter that is allegedly unpatentable over teachings from Woodman, in view of the subject matter taught in U.S. Patent 2,005,340 to Jaffin et al. (hereinafter "Jaffin").

Claim 11 is allowable, among other reasons, for depending indirectly from claim 1, which is allowable.

Woodman in View of Kitamura

Claims 12, 22, 23, and 30 have been rejected under 35 U.S.C. § 103(a) for being drawn to subject matter which is purportedly unpatentable over the subject matter taught in Woodman, in view of the teachings of U.S. Patent 5,733,465 to Kitamura et al. (hereinafter "Kitamura").

Claim 12 is allowable, among other reasons, for depending directly from claim 1, which is allowable.

Claims 22 and 23 are both allowable, among other reasons, for respectively depending directly and indirectly from claim 15, which is allowable.

Claim 30 is allowable, among other reasons, for depending directly from claim 27, which is allowable.

Claims 12, 22, 23, and 30 are also allowable since a *prima facie* case of obviousness has not been established against any of these claims.

In particular, it is respectfully submitted that, without improperly relying upon the hindsight provided by the disclosure of the above-referenced application, one of ordinary skill in the art would not have been motivated to combine the teachings of Woodman and Kitamura in the manner that has been asserted. This is because the teachings of Woodman are drawn to hand-held, manually operated embossing punches with very small dies that are configured for use under the amounts of pressure that can be manually generated, whereas the dies of Kitamura are flexible and configured for use with industrial-sized automated rotary cutting equipment.

Therefore, under 35 U.S.C. § 103(a), the subject matter recited in each of claims 12, 22, 23, and 30 is allowable over the subject matter taught in or suggested by Woodman and Kitamura.

Woodman, Kitamura, and the Purportedly Admitted Prior Art

Claims 13, 14, 31-35, 39, 40, and 42-45 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over that taught in Woodman, in view of teachings from Kitamura and, further, in view of the purportedly admitted prior art.

Claims 13 and 14 are both allowable, among other reasons, for depending indirectly from claim 1, which is allowable.

In addition, claims 13 and 14, as well as claims 31-35, 39, 40, and 42-45 are allowable because teachings from Woodman and Kitamura, with or without the purportedly admitted prior art, cannot be relied upon to establish a *prima facie* case of obviousness against any of these claims under 35 U.S.C. § 103(a).

This is because one of ordinary skill in the art would not, without improperly relying upon the hindsight provided by the disclosure of the above-referenced application, have been motivated to modify a die of a hand-held punch of the type taught in Woodman with features of a flexible die configured for use with an industrial rotary cutting press, as taught in Kitamura.

Moreover, none of Woodman, Kitamura, or the purportedly admitted prior art, taken either collectively or individually, teaches or suggests a system that includes a press with a substantially planar, uninterrupted surface for receiving a die and a die that is substantially rigid and includes a patterning surface with at least one embossing element and at least one cutting edge protruding the same distance therefrom, as are required by independent claim 31, as amended and presented herein.

The rejection of claim 32 is moot, as this claim has been canceled without prejudice or disclaimer.

Therefore, each of claims 13, 14, 31-35, 39, 40, and 42-45 recites subject matter which, under 35 U.S.C. § 103(a), is patentable over the teachings and suggestions of Woodman, Kitamura, and the purportedly admitted prior art.

Woodman, Kitamura, the Purportedly Admitted Prior Art, and Benson

Claims 36-38, 46, and 47 are rejected under 35 U.S.C. § 103(a) for being drawn to subject matter which is allegedly unpatentable over that taught in Woodman, in view of teachings from Kitamura and, further, in view of the purportedly admitted prior art and the subject matter taught in Benson.

Claims 36-38 are each allowable, among other reasons, for depending directly or indirectly from claim 31, which is allowable.

Claims 46 and 47 are both allowable, among other reasons, for depending directly from claim 43, which is allowable.

Each of these claims is additionally allowable since Benson does not include any teaching or suggestion that would have motivated one of ordinary skill in the art to combine the teachings of Woodman and Kitamura in the manner that has been asserted.

Therefore, each of claims 36-38, 46, and 47 is drawn to subject matter that, under 35 U.S.C. § 103(a), is allowable over the subject matter taught or suggested by Woodman, Kitamura, the purportedly admitted prior art, and Benson.

Woodman, Kitamura, the Purportedly Admitted Prior Art, and Jaffin

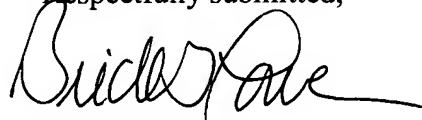
Claim 41 has been rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over that taught in Woodman, in view of teachings from Kitamura and, further, in view of the purportedly admitted prior art and the teachings of Jaffin.

Claim 41 is allowable, among other reasons, for depending indirectly from claim 31, which is allowable and, further, since Jaffin does not include any teaching or suggestion that would have motivated one of ordinary skill in the art to combine the teachings of Woodman and Kitamura in the manner that has been asserted.

**CONCLUSION**

It is respectfully submitted that each of claims 1-20, 22-31, and 33-51 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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